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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/242,960 05/16/94 REID

12M2/0711

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R 252,32951X00  
EXAMINER

CRIARES, T

ART UNIT PAPER NUMBER

1205

DATE MAILED:

07/11/95

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire Three (3) month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- ☒ Notice of References Cited by Examiner, PTO-892.
- ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
- ☐ Notice of Art Cited by Applicant, PTO-1449.
- ☐ Notice of Informal Patent Application, PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐

Part II SUMMARY OF ACTION

1. ☒ Claims 1-11 are pending in the application.

Of the above, claims 10 and 11 are withdrawn from consideration.

- ☐ Claims \_\_\_\_\_ have been cancelled.
- ☐ Claims \_\_\_\_\_ are allowed.
- ☒ Claims 1-9 are rejected.
- ☐ Claims \_\_\_\_\_ are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
- ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

Best Available Copy

EXAMINER'S ACTION

Art Unit 1205

The papers filed May 15, 1995 have been received and entered in the file.

Applicant's election without traverse of Group I, Claims 1-9 in Paper No. 5 is acknowledged.

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Note that Tables III and IV are missing.

Claims 1-9 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited the solvents and polymer to be used in the claimed process since the applicants process in forming

microspheres is known to agglomerate. See Fong U.S. Patent 4,384,975. *See Column 2, lines 47-52*

See M.P.E.P. §§ 706.03(n) and 706.03(z).

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

Art Unit 1205

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103.

Claims 1-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Tice et al. '840. This reference in the abstract and at column 1, line 56 to column 3, line 50 teaches applicants claimed process of combining a polymeric matrix. The difference between applicants <sup>claimed</sup> claims process and the reference is that the reference teaches encapsulation of an anti-inflammatory, whereas the claims read on use of an antigen.

Serial No. 08/242,960


-4-


Art Unit 1205

The skilled artisan would have been motivated to use the reference process to encapsulate the claimed active agent since at column 4, line 62 to column 5 line 10 <sup>of</sup> the reference teaches a ~~number of diseases which would be~~ <sup>the active agent to be</sup> ~~encapsulated could vary~~ <sup>effective to the reference.</sup>

Any inquiry concerning this communication should be directed to T. Criares at telephone number (703) 308-4607.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or 305-3592.

  
CRIARES:bah  
July 10, 1995

  
T.J. CRIARES  
Examiner  
Art Unit 1205